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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,034	09/22/2003	Griscom Bettie III	15783	4995

7590 05/31/2007  
Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
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EXAMINER

CARR, DEBORAH D

ART UNIT PAPER NUMBER

1621

MAIL DATE DELIVERY MODE

05/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/670,034

Applicant(s)

BETTLE ET AL.

Examiner

Deborah D. Carr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 and 63-87 is/are pending in the application.
- 4a) Of the above claim(s) 11-34, 37-61, 63-67, 69, 70, 74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 35, 68, 71-73, 76, 77 and 85-87 is/are rejected.
- 7) ☒ Claim(s) 3-9, 36 and 78-84 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see pages 19-23, filed 16 March 2007, with respect to the rejection(s) of claim(s) 1-2, 10, 35, 62-63, 68 under 35 USC§102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of 35 USC§102.

2. Claims 11-34, 37-61, 64-67, 69-70 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant having timely traversed the restriction (election) requirement in the reply filed on 11 September 2006. The requirement is still deemed proper and remains FINAL.

3. Newly added claims 74-75 are withdrawn from consideration. Newly submitted claims 74-75 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims read on a compound not originally embraced or searched in the original presented invention. Also the claims contain process limitations that were not encompassed in the original invention. These claims would require a completely different search since the originally done search would not have covered the material contained in these claims.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 74-75 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 71-73, 86-87 rejected under 35 U.S.C. 102(a) as being clearly anticipated by Chang et al.

Chang et al. teaches a ceramide library containing tertiary amides that read in the instant compounds. As shown on page 1856 are the core used to produce said amide derivatives. The actual compounds reading on the instant invention are shown in the Chem. Abstr. of the article.

6. Claims 71-72 rejected under 35 U.S.C. 102(b) as being clearly anticipated by translation of JP-05/163203.

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JP'203 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in the Chem. Abstr. of the publication.

7. Claims 71-73, 76-77, 85-86 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shroot et al. (US Pat. 4,877,789).

US'789 teaches fatty acid containing tertiary amides that read in the instant compounds, compositions, and their inclusion in mixtures, see cols. 1-2 & 7. Also taught in col. 2, lines 50-54 are pharmaceutically and cosmetically acceptable salts such as the salts of inorganic acid, which encompasses hydrates, and in amounts that read on the instant transdermal effective amounts (col. 8, lines 26-38).

8. Claims 71-72 rejected under 35 U.S.C. 102(b) as being clearly anticipated by translation of JP-01/201352.

JP'203 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in the Chem. Abstr. of the publication.

9. Claims 1-2, 68 rejected under 35 U.S.C. 102(b) as being clearly anticipated by McGovern et al. (US Pat. 4,797,408).

US'408 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in

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Table 2 and in amounts that read on the instant transdermal effective amounts (col. 5, lines 36-41).

10. Claims 1-2, 68 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Maier et al. (US Pat. 5,455,273).

US'273 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in Chem. Abstr. of the patent and transdermal effective amounts that read on the instant transdermal effective amounts (col. 15 & 16).

11. Claims 1-2 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grega et al. (US Pat. 3,941,783).

US'783 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in Chem. Abstr. of the patent.

12. Claims 1-2, 35, 68, 71-73 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fukumaru et al. (US Pat. 3,995,059).

US'059 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in Chem. Abstr. of the patent and transdermal effective amounts that read on the instant transdermal effective amounts (col. 29).

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13. Claims 71-73 rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP/01-201325.

JP'325 teaches fatty acid containing tertiary amides that read in the instant compounds. The actual compounds reading on the instant invention are shown in Chem. Abstr. of the patent.

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 10 & 85-86 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 & 85-86 recites the limitation "benzethonium linoleamide and benzethonium stearamide" in line 2. There is insufficient antecedent basis for this limitation in the claim. Page 3, section [0008] list the quaternary ammonium salts as a completely different invention and separate from the pharmaceutically acceptable salts of the instant compounds.

***Allowable Subject Matter***

16. Claims 3-9, 36, 78-84 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ddc

  
**DEBORAH D. CARR**  
**PRIMARY EXAMINER**